

Appl. No. 10/084,526
Amdt. Dated Jun. 30, 2004
Reply to Office action of June 2, 2004

Remarks

Claim Rejections Under 35 U.S.C. 103

Examiner has rejected claims 11-17 and 19-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,540,412 to Yonemura in view of U.S. Patent No. 5,111,476 to Yingst, and has also rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Yonemura in view of Yingst in further view of U.S. Patent No. 6,558,191 to Bright. However, applicant maintains and expands his submission that one of ordinary skill in the art could not have derived the module of the present invention in light of Yonemura and Yingst, as detailed below.

Examiner's rejection of claims 11-17 and 19-20 details the same reasons as those provided in the first Office action dated November 17, 2003. Examiner further states to the effect that Yingst teaches an optical transceiver with a printed circuit board 112 having a transmitting circuit and a receiving circuit thereon (lines 6-7, page 10 of the final Office Action), in support of the combination of Yingst and Yonemura.

Applicant traverses Examiner's reasoning as follows:

There is no hint or motivation to combine the printed circuit board 112 having a transmitting circuit and a receiving circuit thereon of Yingst for the optical transceiver of Yonemura. In the BACKGROUND OF THE INVENTION of Yonemura, it is stated that an optical transceiver 280 of the related art has an electronic circuit substrate 281 extending in a horizontal direction, that is, a direction where a light emitting element and a light receiving element are arranged in parallel to each other. It is further states it has not been impossible to narrow the spacing between the light emitting element and the light receiving element, thereby giving the optical transceiver the disadvantage that it cannot

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support small-sized optical connectors (see col. 1, lines 35-43). According to the shortcoming of the related art as described in the patent, Yonemura teaches an optical transceiver with **TWO electronic circuit substrates respectively having a light emitting element and a light receiving element.** The structure of the printed circuit board 112 of Yingst is the same as that described in the related art of Yonemura. That is, one having ordinary skill in the art would have had no hint or motivation to combine the printed circuit board 112 of Yingst with the optical transceiver of Yonemura, because Yonemura itself purports to provide a "complete solution" to the stated related art of which Yingst is an equivalent. Generally speaking, applying the printed circuit board of Yingst to the optical transceiver of Yonemura somewhat *teaches away* from Yonemura.

Accordingly, the small form factor pluggable optoelectronic transceiver module of the present invention cannot be obviously derived from Yonemura in view of Yingst. Therefore, claims 11-17 and 19-20 should be in a condition for allowance.

Claim 18 depends from claim 11; therefore claim 18 should likewise be patentable.

Claim Rejections Under Double Patenting

Claims 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,483,711 to Huang in view of U.S. Patent No. 5,111,476 to Yingst.

Examiner essentially states it would have been obvious to one having ordinary skill in the art to utilize a metal shielding box or shell of Yingst in conjunction with

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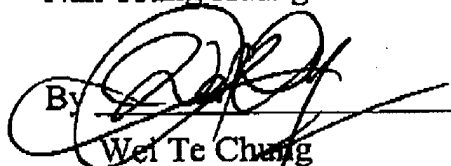
the metal housing and metal chassis of Huang in order to shield and avoid electromagnetic interference between respective covered circuits.

Because allowabilities of claims 11-20 relative to Yonemura and Yingst are still pending, applicant prefers to delay submission of the terminal disclaimer for overcoming the double patent issue until all other rejections to claims 11-20 under 103(a) have been cleared in the future advisory action.

In view of the above claim amendments and remarks and the Terminal Disclaimer, the subject application is believed to be in a condition for allowance, and an action to such effect is earnestly solicited.

Respectfully submitted,

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